REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed August 9, 2005. At the time of the Final Office Action, Claims 1, 3-5, 7-9, 11, 13-15, 17-19, 21, 24, 27 and 28 were pending in this Application. Claims 11, 3-5, 7-9, 11, 13-15, 17-19, 21, 24, 27 and 28 were rejected. Applicants amended claims 1, 11, 27, and 28 and added new claims 29 and 30. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1, 3-5, 7-9, 11, 13-15, 17-19, 21 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,987,249 issued to Franklin C. Grossman et al. ("Grossman et al.") in view of U.S. Patent 6,513,154 issued to John R. Porterfield ("Porterfield"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claims 27 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Grossman et al. and Porterfield as applied to Claims 1 and 11 above, and further in view of U.S. Patent 5,784,621 issued to Yasushi Onishi et al. ("Onishi et al."). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicants amended the independent claims to more clearly distinguish the present invention over the cited prior art. In the advisory action, the Examiner stated in particular that Porterfield provides a user/developer with the option to limit the debug function to a marked are of the program code. Applicants respectfully disagree. According to Porterfield, only an automatic loop debug function is available which is completely handled by the system without any input by the user. According to this loop debug function, which is disclosed in detail in column 17, line 5 to column 18, line 40, the system provides automatically debug instrumentation for any area within a program code that is currently edited or that has been added by the user. Thus, Porterfield does not disclose to manually select a specific program area. Moreover, no display of that selected program code is available. Thus, with a system as proposed by Porterfield, a user will not have the ability to selectively mark any area of the program code which he wishes to analyze. Porterfield does also not graphically indicate which area of a program code is selected for debugging. On the contrary, no display information of which areas are debugged will be available in the Porterfield system.

Furthermore, Porterfield provides debug information only for loops within an edited or added program code. Porterfield is not providing for any debug information such as the display of variables but rather analyzes the edited or added program code for the occurrence of endless loops and accordingly will warn a user if such a loop is executed. However, the system according to Porterfield does not allow for analyzing values of variables used within the marked area.

Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claims to which they refer, respectively. In particular claims 27-30 comprise additional limitations directed to the display of program code and the debug function which is neither disclosed nor mentioned in any of the prior art. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

Request for Continued Examination

Applicants enclose a Request for Continued Examination (RCE) Transmittal, along with a check in the amount of $790.00.

Petition for Extension of Time

Applicants enclose a Petition for Extension of Time for two-months and a check in the amount of $450.00 for the extension fee.
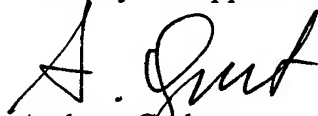
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of all pending claims.

Applicants believe there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
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Andreas Grubert
Limited Recognition No. L0225
Expires June 30, 2006
Limited Recognition Under 37 C.F.R. §11.9(b)

Date: February 6, 2006

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